

Notice of Allowability

Application No.

09/725,713

Examiner

Yogesh C. Garg

Applicant(s)

NII, NAOAKI

Art Unit

3625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☒ This communication is responsive to 9/13/2006 & Interview on 11/24/2006.
2. ☒ The allowed claim(s) is/are 1-23.
3. ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some* c) ☐ None of the:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

* Certified copies not received: _____.


Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application.

THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.

4. ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
5. ☐ CORRECTED DRAWINGS (as "replacement sheets") must be submitted.
- (a) ☐ including changes required by the Notice of Draftsperson's Patent Drawing Review (PTO-948) attached
- 1) ☐ hereto or 2) ☐ to Paper No./Mail Date _____.
- (b) ☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No./Mail Date _____.
- Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the header according to 37 CFR 1.121(d).
6. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

Attachment(s)

1. ☐ Notice of References Cited (PTO-892)
2. ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3. ☒ Information Disclosure Statements (PTO/SB/08),
Paper No./Mail Date 11/30/2000
4. ☐ Examiner's Comment Regarding Requirement for Deposit of Biological Material
5. ☐ Notice of Informal Patent Application
6. ☒ Interview Summary (PTO-413),
Paper No./Mail Date 11/25/2006
7. ☒ Examiner's Amendment/Comment
8. ☒ Examiner's Statement of Reasons for Allowance
9. ☐ Other _____


YOGESH C. GARG
PRIMARY EXAMINER
TECHNOLOGY CENTER 3600

DETAILED ACTION

Response to Amendment

1. The applicant's amendment received on 9/13/2006 is acknowledged and entered. Claims 1 and 19 are amended. Currently claims 1-23 are pending for examination. Claims 24-28 were previously canceled and claims 29-58 were previously withdrawn.

Response to Arguments

2. Applicant's arguments, see Remarks filed on 9/13/2006, with respect rejection of claims 1-23 under 35 USC 112, first paragraph have been fully considered and are persuasive in view of the current amendments made to independent claims 1-23. The rejection of claims 1-23 under 35 USC 112, first paragraph has been withdrawn.

EXAMINER'S AMENDMENT

3. An examiner's amendment to the record appears below. Should the changes and/or additions be unacceptable to applicant, an amendment may be filed as provided by 37 CFR 1.312. To ensure consideration of such an amendment, it **MUST** be submitted no later than the payment of the issue fee.

Authorization for this examiner's amendment was given in a telephone interview with attorney Mr. Shawn Gorman on 11/24/2006.

The application has been amended as follows:

Claims 1, 2 and 19 are amended as follows:

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Claim 1 (Currently amended). A multimedia content delivery system, comprising:

- a content provider providing multimedia files;
- a first integrated circuit card interface **in a multimedia terminal** for receipt of a host integrated circuit card containing first authorization information;
- a second integrated circuit card interface **in said multimedia terminal** for receipt of a user integrated circuit card containing second authorization information;
- an input device for selecting at least one multimedia file from the plurality of multimedia files, **wherein information regarding the selected at least one multimedia file comprises authorization information stored on the first integrated circuit card or the second integrated circuit card;**
- an output device for providing the content of at least one authorized multimedia file provided by the content provider to a user of the user integrated circuit card; and
- a control unit **in said multimedia terminal**, responsive to the host and user integrated circuit cards being received in the first and second integrated circuit card interfaces, which compares the first and second authorization information and when the first and second authorization information is found to be compatible actuates said output device to provide the content of the at least one multimedia file from the content provider selected by said input device under control of the authorization information which authorizes downloading of the at least one authorized multimedia file through the output device, contained in the first and second authorization information; and wherein the content is provided from a database external from the integrated circuit cards.

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Claim 2 (Currently amended) ~~A multimedia content delivery system~~ **The multimedia terminal**, as claimed ed in claim 1, further comprising a ~~multimedia terminal~~ having said content provider, ~~said first integrated circuit card interface~~, and said control unit therein enclosed therein.

Claim 19. (Currently Amended) A process for providing multimedia content from a content provider, comprising ~~the steps of~~:

- (a) storing a multimedia file, having the multimedia content, in a storage unit;
- (b) providing a first integrated circuit card interface **in a multimedia terminal** for receiving of a first integrated circuit card containing first authorization information and a second integrated circuit card interface **in said multimedia terminal** for receiving of a second integrated circuit card containing second authorization information;
- (c) associating first authorization information stored in the first integrated circuit card with at least one multimedia file provided by the content provider;
- (d) receiving the first integrated circuit card and the second integrated circuit card in the integrated circuit card interfaces and comparing the first authorization information with the second authorization information to determine if the first and second authorization information is compatible; and
- (e) in response to step (d) when the first and second authorization is determined to be compatible, **and without requiring a browser**, providing the at least one multimedia file to an output device. to provide the at least one multimedia file from the content provider under control of authorization information, contained in the first and

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second authorization information, which authorizes the downloading of the at least one multimedia file through the output device to a user of the second integrated circuit card; and wherein the content is provided from a database external from the integrated circuit cards.

Claims 29-58 (Canceled).

4. ***Reasons for Allowance***

The following is an examiner's statement of reasons for allowance:

Claims 1-23 are allowed. Claims 1 and 19 are independent and claims 2-18 and 20-23 are dependencies of claims 1 and 19 respectively. Limitations of system claim 1 and process claim 19 are closely parallel and therefore the rationale used by the examiner for reasons for allowance is applicable for both the independent claims 1 and 19 and also for their dependencies.

The prior art of record, either singly or combined, does not fairly teach or suggest or render obvious a process or system configured to, when considered as a whole, inter alia, providing a first integrated circuit card interface in a multimedia terminal for receiving of a first integrated circuit card containing first authorization information and a second integrated circuit card interface in said multimedia terminal for receiving of a

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second integrated circuit card containing second authorization information, associating first authorization information stored in the first integrated circuit card with at least one multimedia file provided by the content provider; receiving the first integrated circuit card and the second integrated circuit card in the integrated circuit card interfaces and comparing the first authorization information with the second authorization information to determine if the first and second authorization information is compatible, and in response to receiving step of the first and second integrated circuit cards in the multimedia terminal determining the first and second authorization as compatible, and without requiring a browser, providing the at least one multimedia file to an output device. to provide the at least one multimedia file from the content provider under control of authorization information, contained in the first and second authorization information, which authorizes the downloading of the at least one multimedia file through the output device to a user of the second integrated circuit card; and wherein the content is provided from a database external from the integrated circuit cards. (see claims 1 and 19).

The applicant's arguments, filed on 9/13/2006, as reproduced below are convincing and supported by the applicant's disclosure:

" First, the '640 patent requires users to browse, search, and/or surf to locate media. as indicated during the Examiner Interview, the Examiner believes the select claims as recited did not specifically exclude the use of a browser and therefore are not distinguishable from the prior art. With respect to claim 19 and its dependent claims, Applicants respectfully disagree. Specifically, Applicants believe the claim limitation as presented in claim 19 affirmatively excludes the use of a browser or any user-initiated browsing since step (e) specifically states "in response to step (d) [receiving the first integrated circuit card and the second integrated circuit card] when the first and second

authorization is determined to be compatible, providing the at least one multimedia file to an output device". (Emphasis added). Thus, according to the recited claim language, even when read as broad as possible, explicitly states the providing of the at least one multimedia file. There is no recitation of any browser or other language to infer that the multimedia file(s) are not provided "in response to" receiving the first integrated circuit card and second integration circuit card. There is further support for such an embodiment in the Specification, "[t]here is no need for browser software in the terminal for downloading purposes. So instead of surfing on the spot, the only active operation the user has to do is to insert a card, or information relating to the card, in the terminal." (Specification, page 6, lines 11 - 13; emphasis added). In fact, perhaps in one exemplary situation, the user may select one or more multimedia files at a remote location and/or through another source, as there is no requirement in the claims that. In specific regards to claim 1 and its dependent claims, the ATM of the '640 patent can at most can be considered to have a first integrated circuit with at most a first authorization information. Thus, neither the '441 patent nor the '640 patent suggest a control unit that compares a first authorization information with a second authorization information, that upon being compatible, actuates an output device to provide content of at least one multimedia file selected by the input device. While the '441 patent may be interpreted as having a first and a second integrated circuit card, there is no actuation of the output device as recited in the rejected claims. Indeed, the first integrated circuit card appears to provide information relating to the service provider whereas the second integrated circuit card relates to parental control over several possible channels that may be viewed upon being manually selected. For example, when the second card is engaged, all the channels that are provided by the service provider are available for viewing, whereas without the card engaged, only a subset, (those approved by the parental controls) are available for viewing. As explicitly provided in the Specification cited by the Office Action, "[i]f the main card is removed from card receptacle 24 none of the transmitted programs [are] decrypted. However, if the parent card is removed from card receptacle 26 only programs which are restricted for viewing under parental control are not decrypted." (The '441 patent; Col. 8, lines 5-9). Thus, an end user must still browse the channels (similar to the browsing as discussed in the '640 patent) to receive channels. Merely applying the dual card functionality of the '441 patent with the control unit of the '640 patent as recited in the rejection does not teach, disclose, or suggest the subject matter of the rejected claims.

In view of the foregoing, the Applicants respectfully disagree that the previous arguments in regards to this rejection merely attacked the references individually. Rather, even when considering each reference together, neither teach, disclose, nor even suggest the subject matter of the rejected claims. Therefore, for at least those reasons discussed above and in previous Responses, the Applicants respectfully request reconsideration and withdrawal of the rejection. "

5. Discussion of most relevant prior art:

The following references have been identified as most relevant prior art to the claimed invention(s).

(i) Combined teachings of Ramachandran et al. (US Patent 6,298,441), hereinafter referred to Ramachandran in view of Handelman et al. (US Patent 6,298,441), hereinafter, referred to as Handelman used in the previous office action mailed on 6/13/2006.

Ramachandran discloses a system and method similar to an ATM machine enabled to dispense cash or digital information including music, etc including a computer processor 12, a display device 14, an input device 16, a card reader 20 for accepting a IC card and is operative to communicate with an external database and servers to carry out financial transfers and download digital information via a network such as Internet (see at least Abstract and col.6, lines 15-52) but does not singly or combined with another prior art fairly suggest or render obvious the unique features of the instant application as underlined above. See also the applicant's remarks above.

Handelman discloses a method of downloading a document from one IC card to another IC card in a terminal and then use the downloaded information in a viewing device (see at least Figs 1-5 and 15 and Abstract and col.2, lines 30-65) but does not singly or combined with another prior art fairly suggest or render obvious the unique features of the instant application as underlined above. See also the applicant's remarks above.

(ii) US Publication 2001/0047223 A1 to Metcalf et al. teaches a method and system of authenticating a purchaser's image by comparing the password stored in a smart card , which is put into a vending machine, with the password stored separately in the vending machine (see at Least Abstract . figs 1-3 and paragraphs 0014-0021).

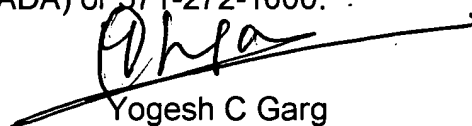
6. Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yogesh C. Garg whose telephone number is 571-272-6756. The examiner can normally be reached on Increased Flex.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey A. Smith can be reached on 571-272-6763. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

A handwritten signature in black ink, appearing to read 'Yogesh C Garg', is written over a horizontal line.

Yogesh C Garg
Primary Examiner
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YCG
11/25/2006